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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/318,353	05/25/99	CASAGRANDE	C 38316-14140 <i>WC</i>
021888		QM12/0622	EXAMINER
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		ART UNIT	PAPER NUMBER
		3722	<i>3</i>
		DATE MAILED:	06/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. 09/318,353	Applicant(s) Charles L. Casagrande
Examiner Mark T. Henderson	Group Art Unit 3722

- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

- Claim(s) 1-24 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1-12, 14-18, and 21-24 is/are rejected.
- Claim(s) 13, 19, and 20 is/are objected to.
- Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on May 25, 1999 is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \*Certified copies not received: \_\_\_\_\_.
- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "8" has been used to designate both a "patch layer" and a "patch" as is stated on page 10, line 15. Correction is required.

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***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that **the abstract not exceed 250 words in length** since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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4. Claim 6 recites the limitations: "the distance" in line 3; "the other corresponding edges" in line 4; and "the other edges" in line 6. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 7 recites the limitation "the distance" in line 2; and "the other corresponding edges" in line 4. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1, 3, 11, 12, 14, 16 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Popat et al (5,662,976).

Popat et al discloses in Fig. 4 and 7, a form with integrated label comprising a form layer (60) having a top surface (A) and a bottom surface (62) and a periphery, at least one die cut (68) through the top and bottom surfaces within the periphery of the form layer defining at least one portion (portion of 60 between 68 and 70) or card intermediate, a patch layer (80) having mirror imaged first and second halves divided by a perforation line (82), a periphery and composed of

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translucent material, top surfaces (80a) and bottom surface (80b), a layer of repositionable, peelable adhesive (58), wherein the bottom surface of the patch layer is adhesively but removably secured (due to release coating 64) to the top surface of the form layer over the entire die cut and form layer portion and wherein the adhesive layer has a greater affinity for the bottom surface of the patch layer than the top surface of the form layer, and wherein the patch layer, adhesive layer and form layer comprising an integrated label (Fig. 7).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 10, 15, 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al in view of Blum et al (4,204,706).

Popat et al discloses in Fig. 4, 5 and 7, a form with integrated label comprising all the elements as claimed in Claim 1, 11 and 12 and as set forth above. Popat also discloses the bottom surface (62) of the form layer being able to accept indicia.

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However, Popat et al does not disclose the top surface of the patch layer and the top surface of the form layer being able to accept indicia.

Blum et al discloses in Fig. 2 and Col. 3, lines 50-56, a form with integrated label having a patch layer (19) and a form layer (17) in which indica can be accepted on the top surfaces thereof through the use of “spot carbonized” method , so that when marking pressure is applied to the outer top surface of the patch layer, a corresponding ink mark is produced on the top surface of the form layer.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Popat et al’s form to include “spot carbonization as taught by Blum et al for the purpose of eliminating the requirement that the patch be folded back to permit marking of indicia on the form surface.

8. Claims 4-7, 9, 17, 18 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al.

Popat et al discloses in Fig. 4, 5 and 7, a form with integrated label comprising all the elements as claimed in Claim 1, 11 and 12 and as set forth above. Popat also discloses a patch layer sized and offset in relation tot he die cut in the form layer such that a distance between an edge (76A) of the patch layer and a corresponding edge of the form layer (70A) is greater than that between other corresponding edges.

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However, Popat et al does not disclose: a patch layer composed of translucent paper glassine, translucent polyester film, opaque material; sized and offset in relation to the die cut in the form layer such that the distance between an edge of the patch layer and a corresponding edge of the from layer portion is less than that between other corresponding edges; the form layer contains multiple die cuts therein defining multiple portions of the form layer.

In regards to **Claims 4-6, 17, 18**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the patch layer in any desirable material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claim 7**, it would have been an obvious matter of design choice to construct the patch layer in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

In regards to **Claim 9 and 23**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any number of die cuts, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

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9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al in view of Stipek (3,914,483).

Popat et al discloses in Fig. 4, 5 and 7, a form with integrated label comprising all the elements as claimed in Claim 1 and as set forth above.

However, Popat does not disclose an integrated label containing a second label comprising portions of the patch within a second die cut extending through the patch layer and to, but not through the form layer portion, wherein the second label is removable.

Stipek discloses in Fig. 5 and 6, an integrated label (51) containing a second label (33) comprising portions of the patch and adhesive layers within a second die cut (53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Popat et al's form to include a label within a label as taught by Stipek for the providing a way in which an inner label can be removed from the main label after it is affixed to a container with the inner label being easily attachable to containers.

***Allowable Subject Matter***

10. Claims 13, 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.

*MTH*  
MTH

June 15, 2000

*A.L. Wellington*  
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